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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/751,050	01/02/2004	Steven Ryals	9400-76 (030599)	2166
39072	7590	08/03/2004	EXAMINER	
MYERS BIGEL SIBLEY & SAJOVEC, P.A.			PATEL, DHIRUBHAI R	
P.O. BOX 37428			ART UNIT	
RALEIGH, NC 27627			PAPER NUMBER	
			2831	

DATE MAILED: 08/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

AK

<b>Office Action Summary</b>	<b>Application No.</b> 10/751,050	<b>Applicant(s)</b> RYALS ET AL.	
	<b>Examiner</b> DHIRU R PATEL	<b>Art Unit</b> 2831	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02 January 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 10-29 is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 1 and 8 are rejected under 35 U.S.C. § 102(b) as being anticipated by D. Dannes (3,408,455).

D. Dannes discloses:

Regarding claims 1 and 8, a retaining member 18 configured to engage the wire, the retaining member comprising a top portion (see fig 1) and a first arm 12 and second arm 14 extending generally perpendicularly from the top portion (see fig 1), wherein junctures between the top portion and the first and second arms are arcuate to engage the wire therein (see fig 1), and at least one securing member 20 connected with the retaining member 18 (see fig 1).

In addition, it has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. In re. Hutchison, 69 USPQ 138.

With respect to claim 8, see fig 1.

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2. Claims 1, 5 and 8 are rejected under 35 U.S.C. § 102(b) as being anticipated by R. A. Lehrke (2,812,380).

R. Lehrk discloses:

Regarding claims 1 and 8, a retaining member 12 configured to engage the wire 28 , the retaining member comprising a top portion 14 (see fig 1) and a first arm 16 and second arm 18 extending generally perpendicularly from the top portion (see fig 1), wherein junctures between the top portion and the first and second arms are arcuate to engage the wire therein (see fig 1), and at least one securing member 20 connected with the retaining member 12 (see fig 1).

In addition, it has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. In re. Hutchison, 69 USPQ 138. With respect to claim 8, see fig 1.

Regarding claim 5, the retaining member comprises a generally flat surface configured to extend a second distance along the length of the wire when mounted on the mounting surface (see fig 1).

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***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103 (a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 2, 7 and 9 are rejected under 35 U.S.C. § 103 (a) as being unpatentable over D. Dannes (3,408,455).

D. Dannes discloses:

Regarding claim 2, Dannes disclose all the features of the claimed invention as shown above, including a first distance between the junctures (inherent features for the junctures), but fails to disclose a first distance between the junctures is about 0.5 inches and 0.7 inches.

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It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the assembly of Dannes with a first distance between the junctures is about 0.5 inches and 0.7 inches, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233 (CCPA 1980).

Regarding claim 7, Dannes disclose all the features of the claimed invention as shown above, but fails to disclose the protector being formed of a polymeric material. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the assembly of Dannes with the protector being formed of a polymeric material, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

Regarding claim 9, Dannes disclose all the features of the claimed invention as shown above, but fails to disclose an adhesive on a side of the retaining member. it would have been an obvious matter of design choice to an adhesive on a side of the retaining member, since applicant has not disclosed that an adhesive on a side of the retaining member solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well with if designed with said retaining member of Dannes.

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4. Claims 6,7 and 9 are rejected under 35 U.S.C. § 103 (a) as being unpatentable over R. A. Lehrke (2,812,380).

R. Lehrk discloses:

Regarding claim 6, R. Lehrk disclose all the features of the claimed invention as shown above, including a second distance between the junctures (inherent features for the junctures), but fails to disclose a second distance between the junctures is about 0.2 inches and 0.5 inches. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the assembly of Dennes with a first distance between the junctures is about 0.2 inches and 0.5 inches, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233 (CCPA 1980).

Regarding claim 7, R. Lehrk disclose all the features of the claimed invention as shown above, but fails to disclose the protector being formed of a polymeric material. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the assembly of R. Lehrk with the protector being formed of a polymeric material, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

Regarding claim 9, R. Lehrk disclose all the features of the claimed invention as shown above, but fails to disclose an adhesive on a side of the retaining member. it would have been an obvious matter of design choice to an adhesive on a side of the retaining member,

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since applicant has not disclosed that an adhesive on a side of the retaining member solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well with if designed with said retaining member of R. Lehrk.

***Allowable Subject Matter***

5. Claims 3-4 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

6. Claims 10-29 are allowed.

The following is a statement of reasons for the indication of allowable subject matter:

The primary reason for the indication of the allowability of claims 3-4, 10-29 are the inclusion therein, in combination as currently claimed, of the limitation of the securing member comprises at least one pointed tip extending from a lower edge and configured to grip the surface (for claims 3-4), and a staple overlying the protector, the staple securing the wire and the protector to the surface (for claims 10-29).

The previously listed limitation is neither disclosed nor taught by the prior art of record, alone or in combination.



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***Contact information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dhiru Patel whose telephone number is 571-272-1983. The examiner can normally be reached on Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dean Reichard can be reached on 571-272-2800 ext 31. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pairedirect.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).

Dhiru Patel  
Primary Examiner  
Group Art Unit 2831  
August 1, 2004

  
8/1/04.  
DHIRU R. PATEL  
PRIMARY EXAMINER